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FACSIMILE TRANSMITTAL SHEET

January 29, 2004

TO: Examiner S. Chunduru
Group Art Unit 1637
U.S. Patent & Trademark Office
FACSIMILE NO.: (703) 872-9306
FROM: David M. Tener, Esq.
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FACSIMILE TRANSMISSION CERTIFICATION

I hereby certify that this correspondence (including the attached Request for Reconsideration) regarding the application identified below, is being transmitted via facsimile to the United States Patent and Trademark Office on this 29th day of January, 2004.


David M. Tener, Reg. No. 37,054

Applicant(s): Glen H. ERIKSON et al.

Serial No: 09/664,827

Group Art Unit: 1637

Filed: September 19, 2000

Examiner: S. Chunduru

Att. Docket No.: E1047/20044

Confirmation No.: 4947

For: QUADRUPLEX DNA AND DUPLEX PROBE SYSTEMS

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION**

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REQUEST FOR RECONSIDERATION

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated October 29, 2003, favorable reconsideration is respectfully requested in view of the following remarks. Claims 1-52 are pending, with claims 26-49 and 52 being withdrawn from consideration pursuant to a restriction requirement.

It is initially noted that claim 6 has not been rejected, but has not been identified in the Office Action as being allowable. Accordingly, Applicants respectfully request that the Office acknowledge the allowability of claim 6.

Claims 1-4, 7-9, 13-14 and 19 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by McGavin et al., J. Mol. Graphics, Vol. 7, pp. 218-232, 1989 (hereinafter "McGavin"). This rejection is respectfully traversed.

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McGavin discloses a theoretical model for quadruplex nucleic acid sequences based on the Watson-Crick base tetrads. See McGavin at page 225, left column, first paragraph under "Introduction". McGavin does not disclose or suggest how the structures described by the computer models could be prepared using real nucleic acids. Thus, McGavin is non-enabling prior art. In *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education & Research*, 304 F.3d 1221, 1227 (Fed. Cir. 2002), the court held:

The disclosure in an assertedly anticipating reference must be adequate to enable possession of the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation.

See also *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) ("It is well settled that prior art under 35 U.S.C. §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling.").

The Office Action makes no attempt to show that the theoretical structural models of McGavin would have enabled one of ordinary skill in the art to prepare the multiplex structure of claims 1-4, 7-9, 13-14 and 19 without undue experimentation. Thus, the Office Action fails to make a *prima facie* case of anticipation.

Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 1-4, 7-9, 13-14 and 19 over McGavin et al. are respectfully requested.

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Claims 5, 10-12, 15-18, 20-25 and 50-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McGavin in view of U.S. Patent No. 6,420,115 to Erikson et al. This rejection is respectfully traversed.

McGavin fails to identically disclose all the limitations of dependent claims 5, 10-12, 15-18, 20-25 and 50-51 for at least the same reasons (noted above) that it fails to identically disclose all the limitations of base claim 1. McGavin discloses theoretical, computer-based models for multiplex nucleic acid sequences based on Watson-Crick bonding, but does not disclose or suggest how the virtual structures described by the computer models could be prepared using real nucleic acids. Thus, McGavin is a non-enabling reference, which the Office Action applies based on an improper "obvious-to-try" standard of obviousness. In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 726, 16 USPQ2d 1923, 1929 (Fed. Cir. 1990), the court held:

[A]n "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). However, we have consistently held that "obvious to try" is not to be equated with obviousness under 35 U.S.C. §103.

Erikson et al., like McGavin, is improperly applied to reject the claimed invention, albeit for a different reason. Erikson et al. is a continuation-in-part of U.S. patent application Ser. No. 09/468,679, filed Dec. 21, 1999. Neither Erikson et al. nor its parent application were patented or published prior to the filing date of the present application. Thus, Erikson et al. does not qualify as

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prior art under 35 U.S.C. § 102(a) or 102(b). This leaves 35 U.S.C. § 102(e) as the only possible basis upon which the Office Action applied Erikson et al.

The present application and U.S. Patent No. 6,420,115 to Erikson et al. were, at the time the invention of the present application was made, both 100% owned by Ingeneus Corp. Such ownership is evidenced by the assignments from the inventors to Ingeneus Corp. of all rights in the present application (recorded in the PTO assignment records at Reel 011152, Frame 0560) and all rights in U.S. Patent No. 6,420,115 to Erikson et al. (recorded in the PTO assignment records at Reel 010947, Frame 0663). Thus, Erikson et al. cannot be applied in an obviousness rejection of the present claims, pursuant to 35 U.S.C. § 103(c), which provides:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Accordingly, reconsideration and withdrawal of the obviousness rejection over McGavin et al. in view of Erikson et al. are respectfully requested.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

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Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

January 29, 2004

Please charge or credit our Account
No. 03-0075 as necessary to effect
entry and/or ensure consideration of
this submission.

By 

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